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| EXAMINER       |  |
| GARG, YOGESH C |  |

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| 3625     |              |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/672,523 | <b>Applicant(s)</b><br>JOSEPH ET AL. |  |
|                              | <b>Examiner</b><br>Yogesh C. Garg    | <b>Art Unit</b><br>3625              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,10,11,13-25,27-29,31-39,41-43,45-55,57-59,61-67,246-253 and 260 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/27/07&amp;3/30/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/27/2007 has been entered.

In the current submission none of the claims has been amended. Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 are pending for examination.

Applicant's letter filed on 3/27/2007 providing information about the related applications to the present application is acknowledged and filed.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 3/27/2007 with the RCE and on 3/30/2007 is being considered by the examiner.

### ***Response to Arguments***

3.1. The applicant has not submitted any arguments in the submission filed with RCE on 3/27/2007.

3.2. Applicant's arguments, see pages 1-2, filed in the Pre-Appeal Brief

Art Unit: 3625

Request on 8/4/2006, with respect to rejection of claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based have been fully considered and are persuasive. The rejection of claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 under 35 U.S.C. 251 has been withdrawn because the subject matter of claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 is new and not related to the claimed subject matter surrendered in the application for the patent upon which the present reissue is based. However, upon further consideration, a new ground(s) of rejection is made in view of the fact that claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 do not satisfy USC 112, first paragraph.

3.3. Applicant's arguments, see pages 3-4, filed in the Pre-Appeal Brief

Request on 8/4/2006, with respect to rejection of claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 under 35 U.S.C. 103(a) have been fully considered but they are not persuasive. The applicant argues that " the ordering of an item, as disclosed in Schlafly, requires more than a single action with respect to the client because . . . . . In short, Schlafly simply does not disclose placing an order for an item by a single action with respect to a client, but instead clearly discloses a sequence of actions". The applicant respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the previously stored

Art Unit: 3625

information related to ordering an item cannot include an individual subscriber secret personal authorization number followed by prompts responsive to which the user enters a code specifying a supplier, the nature of the transaction, quantity and options relating to an item being ordered) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the applicant's disclosure (see at least '034 patent, col.8, line 34-col.9, line 2) teaches receiving and storing information related to the item being purchased and personal information of the user by interacting with the user in more than one actions. In Schlafly once all the information related to order is collected then it takes one action to transmit the order (see Abstract, col.1, lines 44-57, "*The users of the system are provided with convenient hand-holdable battery powered terminals with a limited number of order and function keys. This terminal is used by the consumer to initially select and store data representative of the orders. When later connected to a phone line the terminal can be commanded to automatically dial and transmit the stored data in a short burst over a telephone link to a local processing center for processing including customer verification, data format and credit verification, order placement and supplier contact. Each terminal is assigned an internal identification number and a specific local processing center which the terminal can automatically access.*" , and col.7, lines 35-46).

### **Claim Rejections - 35 USC § 251**

4. Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 rejected under 35 U.S.C. 251 as being based upon new matter added to the patent

Art Unit: 3625

for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control resulting in appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer.

The claims, as recited, claim a broader scope than disclosed. The claim language of claims encompasses that the personal information can be stored in a memory which could be external to the client such as an external server [a memory in a server when in communication with a client is also associated with the client] and that would imply not appending the personal information from the permanent memory in the client at the time of selecting a currently offered item using the client computer. Storage of personal information in the open server environment is not originally disclosed or enabled and did not form part of invention as originally filed. At the time of the applicant's invention one of an ordinary skilled in the art would not have viewed open server environment disclosed to have been able to maintain the security of the personal information anywhere in the network other than as resident in the client computer memory to append this personal information with an item number at the time when user

Art Unit: 3625

presses a button on a remote TV module to order a currently displayed viewing information on screen and selects the item.

The applicant's attention is also invited to MPEP 2163.05 Changes to the Scope of Claims [R-2], " **The failure to meet the written description requirement of 35 U.S.C. 112, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations**, or to alter a numerical range limitation or to use claim language which is not synonymous with the terminology used in the original disclosure. **To comply with the written description requirement of 35 U.S.C. 112, para. 1**, or to be entitled to an earlier priority date or filing date under 35 U.S.C. **119, 120, or 365(c)**, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § **2163** for examination guidelines pertaining to the written description requirement.

#### **I. BROADENING CLAIM**

##### **Omission of a Limitation**

**A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) .....**

In the present case, the claims as recited omit essential elements/critical features of the invention as explained above and therefore do not comply with the written description requirement .

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 5.1. Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer.

The claims, as recited, claim a broader scope than disclosed. The claim language of claims encompasses that the personal information can be stored in a



Art Unit: 3625

memory which could be external to the client such as an external server [a memory in a server when in communication with a client is also associated with the client] and that would imply not appending the personal information from the permanent memory in the client at the time of selecting a currently offered item using the client computer. Storage of personal information in the open server environment is not originally disclosed or enabled and did not form part of invention as originally filed. At the time of the applicant's invention one of an ordinary skilled in the art would not have viewed open server environment disclosed to have been able to maintain the security of the personal information anywhere in the network other than as resident in the client computer memory to append this personal information with an item number at the time when user presses a button on a remote TV module to order a currently displayed viewing information on screen and selects the item.

The applicant's attention is also invited to MPEP 2163.05 Changes to the Scope of Claims [R-2], " The failure to meet the written description requirement of **35 U.S.C. 112**, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim language which is not synonymous with the terminology used in the original disclosure. To comply with the written description requirement of 35 U.S.C. **112**, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. **119**, **120**, or **365(c)**, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § **2163** for examination guidelines pertaining to the written description requirement.

Art Unit: 3625

## **I. BROADENING CLAIM**

### **Omission of a Limitation**

A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) .....

In the present case, the claims as recited omit essential elements/critical features of the invention as explained above and therefore do not comply with the written description requirement.

5.2. Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored in a **permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer.

The claims, as recited, claim a broader scope than disclosed. The claim language of claims encompasses that the personal information can be stored in a memory which could be external to the client such as an external server [a memory in a server when in communication with a client is also associated with the client] and that would imply not appending the personal information from the permanent memory in the client at the time of selecting a currently offered item using the client computer. Storage of personal information in the open server environment is not originally disclosed or enabled and did not form part of invention as originally filed. At the time of the applicant's invention one of an ordinary skilled in the art would not have viewed open server environment disclosed to have been able to maintain the security of the personal information anywhere in the network other than as resident in the client computer memory to append this personal information with an item number at the time when user presses a button on a remote TV module to order a currently displayed viewing information on screen and selects the item. Therefore, the claims as recited contain subject matter, that is storing the personal information in a memory external to client, in an open server environment which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5.3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3625

Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements/steps/ essential structural cooperative relationships of elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

The disclosed embodiment (see applicant's prior patent, col.8, lines 52-col.9, line 2), recites following critical factors to implement the claimed inventions:

The personal information is stored **in a permanent memory in the client computer** [such as a set-top box of the TV] **and not external to the client computer** such that the user while viewing an item on TV screen wanting to order the item can press one button on the remote control. Pressing the button triggers appending the previously stored personal information from the permanent memory of the client with the item number currently being offered on the TV screen and transmitting the order to a central computer. The claims, as recited, do not include the above critical features.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3625

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 12, 15, 16, 21-25, 28, 33-36, 38, 40, 43, 50-54, 58, 60, 63-66, 260, 262, and 263 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pat. No. 5,621,456, Florin et al (hereinafter Florin) in view of Pat. No. 4,734,858, Schlafly.

As to claim 10, Florin discloses a method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method comprising (i.e. home shopping interface)(see Fig. 1, and col. 23, line 59 - col. 24, line 7):

receiving data at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale (see col.24, lines 7-39 and Figs. 45-48 discloses receiving data including information to at least one of show (that is the Advertiser's show, for example of " The Attic at Cacy"s in Fig.45) and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale (see Figs. 46-48 which show that an item is identified by its name, such as "Lucks Mini Espresso" and this item is currently being offered for sale and it is described in Fig.48).

Art Unit: 3625

showing or describing the item to a user via the client (i.e. full motion video display of various paid for commercials or advertising messages)(see Fig. 44-50 and col. 23, line 67 - col. 24, line 7);

enabling the user to place an order for the item by a single interaction with the client (see Fig. 45-50, order button 409); and

in response to the single interaction with the client, causing the order for the item to be placed (i.e. select button is depressed to order the product)(col. 24, lines 39-53). Florin does not explicitly disclose ordering the item by a single action with the client; and wherein the enabling of the user to order the item by a single action includes using 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed and 2) the item finder to enable the client to identify the item as currently being offered for sale at the time at the time of the single action.

However Schlafly discloses order the item by a single action with the client (i.e. once the item has been specified, it can be reviewed and modified or it can be stored in a send memory at 92 and later caused to be sent by automatic dialing of the local processing center ...)(see at least Abstract, col.1, lines 44-57 and col. 7, lines 35-46). In addition, Schlafly discloses wherein the enabling of the user to order the item by a single action includes using 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for

Art Unit: 3625

further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed (i.e. user ID number is then stored in the send memory)(col. 9, lines 12

21) and 2) the item finder to enable the client to identify the item as currently being offered for sale at the time of the single action (i.e. order information including the item code)(col. 9, line 52 - col. 10, line 10). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include order the item by a single action with the client; and wherein the enabling of the user to order the item by a single action includes using 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed and 2) previously received information related to the item being offered for sale at the time of the single action as disclosed by Schlafly within Florin for the motivation of allowing consumers to order goods from a wide variety and broad range of suppliers (col. 1, lines 36-41).

As to claim 15, Florin discloses the method of claim 10, wherein the distributed computing system is an interactive television system and wherein the showing or describing of the item is, at least in part, by television signal (i.e. TV Shop is presented as a television channel)(col. 23, lines 59-67).

As to claim 16, Florin discloses the method of claim 10, wherein the client includes an auxiliary data processor (unit 77) and a client computer (unit 62)(see Fig 2).

As to claim 21, Florin discloses the method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method comprises:

sending information used in processing the order from the client to the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 22, Florin discloses the method of claim 10, further comprising:

sending an order confirmation to the user to confirm the order (i.e. a confirmation of the order along with a delivery time is displayed to the user)(col. 24, lines 53-58).

As to claim 23, Florin discloses the method of claim 21, further comprising:

communicating information between the client and the server via the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).



Art Unit: 3625

As to claim 24, Florin discloses the method of claim 23, wherein a telephone system acts as the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 25, Florin discloses the method of claim 10 including receiving at the client data including. Florin does not disclose information to enable the user to order the item by the single action with respect to the client. However, Schlafly discloses information to enable the user to order the item by the single action with respect to the client (i.e. user ID number is then stored in the send memory)(col. 9, lines 12-21). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include information to enable the user to order the item by the single action with respect to the client as disclosed by Schlafly within Florin for the motivation of allowing consumers to order goods from a wide variety and broad range of suppliers (col. 1, lines 36-41).

As to claim 28, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

Art Unit: 3625

As to claim 33, Florin discloses the method of claim 28, including providing the information in the form of a television signal (i.e. TV Shop is presented as a television channel)(col. 23, lines 59-67).

As to claim 34, Florin discloses the method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1, transceiver 54 and col. 8, lines 19-31).

As to claim 35, Florin discloses the method of claim 34 wherein a telephone system acts as a central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 36, Florin discloses the method of claim 28 including providing an order confirmation to the client to confirm the order (i.e. a confirmation of the order along with a delivery time is displayed to the user)(col. 24, lines 53-58).

As to claim 38, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 43, Florin discloses the system of claim 38, wherein the distributed computing system is an interactive television system and wherein the showing and/or describing of the item by the data processing system is, at least in part, performed utilizing a television signal (i.e. TV Shop is presented as a television channel)(col. 23, lines 59-67).

As to claim 49, Florin discloses the system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 50, limitations are closely parallel to the limitations already covered in claim 22 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 51, Florin discloses the system of claim 49, wherein the central processing facility is to communicate information between the client and the server (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 52, Florin discloses the system of claim 51 wherein a telephone system acts as the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1 and col. 8, lines 19-31).

As to claim 53, limitations are closely parallel to the limitations already covered in claim 25 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 58, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

As to claim 63, Florin discloses the system of claim 58, wherein the data source is to provide the information in the form of a television signal (i.e. TV Shop is presented as a television channel)(col. 23, lines 59-67).

Art Unit: 3625

As to claim 64, Florin discloses the system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1, transceiver 54 and col. 8, lines 19-31).

As to claim 65, Florin discloses the system of claim 64 wherein a telephone system acts as the central processing facility (i.e. cable or telephone service provider provides cable television or telephone services over a T/T cable to a plurality of users coupled to the cable or telephone system)(see Fig. 1, transceiver 54 and col. 8, lines 19-31).

As to claim 66, Florin discloses the system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order (i.e. a confirmation of the order along with a delivery time is displayed to the user)(col. 24, lines 53-58).

As to claim 260, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

Art Unit: 3625

As to claim 262, Florin discloses the machine-readable medium of claim 260, wherein the medium comprises a mass storage device(i.e. central file server)(Fig. 1 and col. 3, lines 2-8).

As to claim 263, limitations are closely parallel to the limitations already covered in claim 10 and is therefore analyzed and rejected on the basis of same rationale as being unpatentable over Florin in view of Schlafly.

6. Claims 11, 29, 39, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claims 10, 28, 38, and 58 above, and further in view of Zachary et al., "Technology: HP is building Gadget to Make TVS Interactive" (hereinafter Zachary).

As to claim 11, Florin and Schlafly do not explicitly disclose the method of claim 10, wherein the single action includes at least one of a group including:

- selecting of a single button; and
- pressing of a single button on a TV remote control.

However, Zachary discloses an interactive TV system including a TV control box and a remote controller so that a home user can shop (see abstract and page 1). While shopping on the interactive TV system, a user can press the remote controller to place an order for a product (see abstract and page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim

Art Unit: 3625

10, wherein the single interaction is one of the group including selecting of a single button and pressing of a single button on a TV remote control as disclosed by Zachary within Florin and Schlafly in order to make it easier for customer to make a purchase after watching an ad (see page 2, paragraph 9).

As to claims 29, 39, and 59, the claims are similar in scope to claim 11 and are rejected for the same reasons.

7. Claims are 13,14,17, 31, 32, 41, 42, 45, 61, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claims 10, 28, 38, and 58 above, and further in view of Pires, Pat. No. 4,163,255.

As to claim 13, Florin does not explicitly disclose the method of claim 10, wherein the personal information includes at least one of the group including a user's name, address, method of payment and payment account number.

However, Pires discloses a billing method for a subscriber of a pay television system (see abstract). Pires further discloses storing a customer identifier in client memory (i.e. decoder) along with order information including a program identifier to identify the program being ordered (col. 3, lines 27-33 and col. 4, lines 5-18 and lines 46-52). The customer and program identifiers are then transmitted from the client (i.e. decoder) to the central computer (col. 4, lines 46-52). Although Pires does not disclose the personal information includes at least one of the group including user's

Art Unit: 3625

name, address, method of payment and payment account number, Pires does transmit the customer identifier which identifies the customer ordering the item.

Transmitting a customer identification number is equivalent to providing the user's name since both means identify the user submitting the order. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 12, wherein the personal information includes at least one of the group including a user's name, address, method of payment and payment account number as disclosed by Pires within Florin and Schlafly in order to furnish a billing system which is reliable and operates with a minimum of user effort (col. 1, lines 32-36).

As to claim 14, Florin does not explicitly disclose the method of claim 10, wherein the personal information is stored in memory in the client.

However, Pires discloses a billing method for a subscriber of a pay television system (see abstract). Pires further discloses storing a customer identifier in client memory (i.e. decoder) along with order information including a program identifier to identify the program being ordered (col. 3, lines 27-33 and col. 4, lines 5-18 and lines 46-52). The customer and program identifiers are then transmitted from the client (i.e. decoder) to the central computer (col. 4, lines 46-52). Although Pires does not disclose the personal information includes at least one of the group including user's name, address, method of payment and payment account number, Pires does transmit the customer identifier which identifies the customer ordering the item. Transmitting a



Art Unit: 3625

customer identification number is equivalent to providing the user's name since both means identify the user submitting the order. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 12, wherein the personal information is stored in memory in the client as disclosed by Pires within Florin and Schlafly in order to furnish a billing system which is reliable and operates with a minimum of user effort (col. 1, lines 32-36).

As to claim 17, Florin does not explicitly disclose the method of claim 10, wherein the client is associated with at least a set top box, and wherein the personal information is stored at the set top box.

However, Pires discloses a billing method for a subscriber of a pay television system (see abstract). Pires further discloses storing a customer identifier in a set top box (i.e. decoder) along with order information including a program identifier to identify the program being ordered (col. 3, lines 27-33 and col. 4, lines 5-18 and lines 46-52). The customer and program identifiers are then transmitted from the set top box (i.e. decoder) to the central computer (col. 4, lines 46-52). Although Pires does not disclose the personal information includes at least one of the group including user's name, address, method of payment and payment account number, Pires does transmit the customer identifier which identifies the customer ordering the item. Transmitting a customer identification number is equivalent to providing the user's name since both means identify the user submitting the order. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 12, wherein the client is

Art Unit: 3625

associated with at least a set top box, and wherein the personal information is stored at the set top box as disclosed by Pires within Florin and Schlafly in order to furnish a billing system which is reliable and operates with a minimum of user effort (col. I, lines 32-36).

As to claims 31, 32, 41, 42, 45, 61, and 62, the claims are similar in scope to claims 13, 14, and 17 and the claims are rejected for the same reasons.

8. Claims 37, 54, 55, 67 and 246-253 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claims 25, 28, 53, and 58 above, and further in view of Harvey et al., Pat. No. 4,965,825 (hereinafter Harvey).

As to claim 246, Florin does not explicitly disclose the method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single interaction with the client.

However, Harvey discloses an interactive television system where a central broadcast location includes signals carrying commands, executable code (i.e. control instructions) and data and transmits the signal for receipt by computer systems at viewer locations (col. 6, lines 43-62 and col. 13, line 54- col. 14, line 8). The transmitted signals contain control instructions that control the client computer (instructions are addressed to and control the microcomputer 205 of each subscriber station)(col. 12, lines 47-57). The user can then input information under control of signals embedded in the transmitted datastream (i.e. broadcast signal)(col. 13, lines 31-41). Furthermore, Harvey discloses an using the interactive television system to allow users to order items

Art Unit: 3625

(i.e. Or if you enter on your Widget Signal Generator TV568\* and Local Input the information that you see here on your screen ... the ingredients you need for your recipe will be delivered in time for dinner tomorrow.)(col. 280, line 58-vol. 281, line 5, line 61 - 68). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single interaction with the client as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations)and transmit standardized programming that is simple for users to play and understand (col. 6, lines 43-63).

As to claim 247, Florin does not explicitly disclose the method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single interaction with the client. However, Harvey discloses an interactive television system where a central broadcast location includes signals carrying commands, executable code (i.e. control instructions) and data and transmits the signal for receipt by computer systems at viewer locations (col. 6, lines 43-62 and col. 13, line 54- col. 14, line 8). The transmitted signals contain control instructions that control the client computer (instructions are addressed to and control the microcomputer 205 of each subscriber station)(col. 12, lines 47-57). The user can then input information under control of signals embedded in the transmitted datastream (i.e.

Art Unit: 3625

broadcast signal)(col. 13, lines 31-41). Furthermore, Harvey discloses an using the interactive television system to allow users to order items (i.e. Or if you enter on your Widget Signal Generator TV568\* and Local Input the information that you see here on your screen ... the ingredients you need for your recipe will be delivered in time for dinner tomorrow.)(col. 280, line 58-vol. 281, line 15 and line 61 -68). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single interaction with the client as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (col. 6, lines 43-63).

As to claims 248-253, the claims are similar in scope to claims 246 and 247 and are rejected for the same reasons.

As to claim 37, Florin does not explicitly disclose the method of claim 248 including multiplexing, the provision of the information and the code to the client to thereby generate data for transmission to the client.

However, Harvey discloses multiplexing, the provision of the information and the code to the client to thereby generate data for transmission to the client (i.e. the present

Art Unit: 3625

invention has the capacity for transmitting data and control instructions in the same information stream to many different apparatus at a given subscriber station)(col. 6, lines 49-63, col. 22, lines 62-65 and col. 23, lines 15-44). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 248 including multiplexing, the provision of the information and the code to the client to thereby generate data for transmission to the client as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (col. 6, lines 43-63).

As to claim 54, Florin does not explicitly disclose the system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to show and/or describe from the data and a packet data extractor to extract the information to enable from the data. However, Harvey discloses multiplexing, the provision of the information and the code to the client to thereby generate data for transmission to the client (i.e. the present invention has the capacity for transmitting data and control instructions in the same information stream to many different apparatus at a given subscriber station)(col. 6, lines 49-63, col. 22, lines 62-65 and col. 23, lines 15-44). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to show and/or describe from the data and a

Art Unit: 3625

packet data extractor to extract the information to enable from the data as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (Col. 6, lines 43-63).

As to claim 55, the claim is similar in scope to claim 54 and is rejected for the same reasons.

As to claim 67, the claim is similar in scope to claim 37 and is rejected on the same basis.

9. Claims 27 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claim 26 above, and further in view of Harvey.

As to claim 27, Florin does not explicitly disclose the method of claim 26 wherein the item identifier includes any one of a group of identifiers including a code and a command. However, Harvey discloses an interactive television system where a central broadcast location includes signals carrying commands, executable code (i.e. control instructions) and data and transmits the signal for receipt by computer systems at viewer locations (col. 6, lines 43-62 and col. 13, line 54- col. 14, line 8). The transmitted signals contain control instructions that control the client computer (instructions are addressed to

Art Unit: 3625

and control the microcomputer 205 of each subscriber station)(col. 12, lines 47-57). The user can then input information under control of signals embedded in the transmitted datastream (i.e. broadcast signal)(col. 13, lines 31-41). Furthermore, Harvey discloses an using the interactive television system to allow users to order items (i.e. Or if you enter ,1 ,on your Widget Signal Generator TV568\* and Local Input the information that you see here on your screen ... the ingredients you need for your recipe will be delivered in time for dinner tomorrow.)(col. 280, line 58-vol. 281, line 15 and line 61-68). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 26 wherein the item identifier includes any one of a group of identifiers including a code and a command as taught by Harvey within Florin and Schlafly in order to transmit data and control instructions in the same datastream (i.e. information stream) to many different clients (i.e. different apparatus at subscriber stations) and transmit standardized programming that is simple for users to play and understand (cot. 6, lines 43-63).

As to claim 57, the claim is similar in scope to claim 27 and is rejected on the same basis.

10. Claim 261 is rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claim 260 above, and further in view of Harvey.

As to claim 261, the claim is similar in scope to claim 37 and is rejected for the same reasons.

Art Unit: 3625

11. Claims 18-20 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin and Schlafly as applied to claim s 10 and 38 above, and further in view of Mustafa et al., Pat. No. 4,789,895 (hereinafter Mustafa).

As to claim 18, Florin does not explicitly disclose the method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further comprises:

the client retrieving information from one or more of the local computer and the associated storage. However, Mustafa discloses the set top box (unit 33) is in communication with a local computer and associated storage and wherein the method further comprises the client retrieving information from one or more of the local computer and the associated storage (see Fig. 1, col. 3, lines 12-20, col. 4, lines 3-20, and col. 6, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the set top box is in communication with a local computer and associated storage and wherein the method further comprises the client retrieving information from one or more of the local computer and the associated storage as taught by Mustafa within Florin and Schlafly in order to synchronize a datastream sent from a central facility to a terminal in an interactive television system so that many users can initiate and interact with programs and services at different times (col. 2, lines 21-32).

As to claim 19, the method of claim 18, wherein the method further comprises: controlling the client by means of the local computer. However, Mustafa discloses the set top box (unit 33) is in communication with a local computer and associated storage and



Art Unit: 3625

the client retrieves information from one or more of the local computer (see Fig. 1, col. 3, lines 12-20, col. 4, lines 3-20, and col. 6, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 18, wherein the method further comprises controlling the client by means of the local computer as taught by Mustafa within Florin and Schlafly in order to synchronize a datastream sent from a central facility to a terminal in an interactive television system so that many users can initiate and interact with programs and services at different times (col. 2, lines 21-32).

As to claim 20, Florin does not explicitly disclose the method of claim 18, wherein the local computer is part of a local area network. However, Mustafa discloses the method of claim 18, wherein the local computer is part of a local area network (see Fig. 1, col. 3, lines 12-20, col. 4, lines 3-20, and col. 6, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 18, wherein the local computer is part of a local area network as taught by Mustafa within Florin and Schlafly in order to synchronize a datastream sent from a central facility to a terminal in an interactive television system so that many users can initiate and interact with programs and services at different times (col. 2, lines 21-32).

As to claims 46-48, the claims are similar in scope to claims 18-20 and are rejected on the same basis.

Art Unit: 3625

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
4/13/2007.

*Pls. ENTER This Communication in File wrapper.*

**S/N 09/672,523**

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Kuriacose Joseph et al.

Examiner: Yogesh C. Garg

Serial No.: 09/672,523

Group Art Unit: 3625

Filed: September 27, 2000

Docket: 2050.001US3

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

**COMMUNICATION CONCERNING RELATED APPLICATION(S)**

MS RCE

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicants would like to bring to the Examiner's attention the following related application(s) in the above-identified patent application:

| <u>Serial/Patent No.</u> | <u>Filing Date/Issue Date</u> | <u>Attorney Docket</u> | <u>Title</u>   |
|--------------------------|-------------------------------|------------------------|--|
| 08/233,908<br>5,819,034  | April 28, 1994                | 2050.001US1            | APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS AS FOR A MULTIMEDIA SYSTEM  |
| 08/819,274<br>5915090    | March 18, 1997                | 2050.001US2            | APPARATUS FOR TRANSMITTING A DISTRIBUTED COMPUTING APPLICATION ON A BROADCAST TELEVISION SYSTEM  |
| 09/903,458               | July 10, 2001                 | 2050.001US4            | APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS AS FOR A MULTIMEDIA SYSTEM, AND METHOD AND SYSTEM TO ORDER AN ITEM USING A DISTRIBUTED COMPUTING SYSTEM |
| 09/903,448               | July 10, 2001                 | 2050.001US5            | APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS AS FOR A MULTIMEDIA SYSTEM, AND SYSTEM TO ORDER AN ITEM USING A DISTRIBUTED COMPUTING SYSTEM            |
| 09/903,457               | July 10, 2001                 | 2050.001US6            | APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS AS FOR A MULTIMEDIA SYSTEM, AND METHOD AND SYSTEM TO ORDER AN ITEM USING A DISTRIBUTED COMPUTING SYSTEM |

*Yogesh*

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COMMUNICATION CONCERNING RELATED APPLICATIONS  
Serial Number: 09/672,523  
Filing Date: September 27, 2000  
Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

Page 2  
Dkt: 2050.001US3

|            |               |             |   |
|------------|---------------|-------------|---|
| 09/903,091 | July 10, 2001 | 2050.001US7 | METHOD AND SYSTEM TO<br>FACILITATE COMMUNICATIONS<br>AND CONTROLS BETWEEN A CLIENT<br>AND A COLOCATED LOCAL<br>COMPUTER |
|------------|---------------|-------------|---|

Continuations and divisionals may be later filed on the cases listed above, or cited to the Examiner in any previous Communication Concerning Related Applications. Applicants request that the Examiner review all continuations and divisionals of the above-listed or previously-cited patent applications before allowing the claims of the present patent application.

Respectfully submitted,

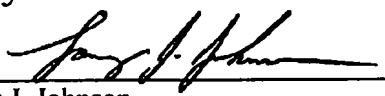
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Date March 27, 2007

By

  
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Reg. No. 56,861

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27 day of March, 2007.

Peter Rehffoni  
Name

  
Signature